REMARKS

Claims 1-24 were previously rejected on prior art grounds. Claims 10 and 20 were previously rejected upon informalities. Claims 1-6, 8-18, and 20-24 were previously amended to overcome the prior art rejections and rejections upon informalities. Claims 7 and 19 were previously canceled without prejudice or disclaimer. Claims 25-27 are added herein. Therefore, claims 1-6, 8-18, and 20-27 are all the claims presently pending in the application. Applicants respectfully traverse these rejections/objections based on the following discussion.

I.   The Prior Art Rejections

Claims 1-6, 10-12, 14-18, 20-22 and 24 stand rejected under 35 U.S.C. §102(e) as being anticipated by Sweet, et al. (U.S. Patent No. 6,415,278), hereinafter referred to as "Sweet." Claims 7-9 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sweet in view of Nishizawa (U.S. Patent No. 6,537,325). Claims 13 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sweet in view of Cohen, et al. (U.S. Publication No. 2002/0164000), hereinafter referred to as "Cohen." To reiterate Applicants position provided in the amendments filed on August 17, 2004 and January 18, 2005, Applicants respectfully traverse these rejections based on the following discussion.

Sweet teaches a method and computer program for retrieving documents transitively linked to an initial document includes retrieving the initial document, the initial document being within a directory path; and retrieving only those other documents for which there is a transitive link from the initial document to the other document and for which the transitive link includes documents which are all within the directory path. The initial document is on a hierarchical file system which is distributed on a network or an internet.

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Nishizawa teaches a document comprehension support apparatus includes an original text analysis unit which divides an original text into significance paragraphs, the significance paragraphs being separated from each other at boundaries that are determined based on sums of points rated for individual sentences in the original text, each significance paragraph containing a group of sentences. A summarized text generating unit calculates a sum of significance indexes for each of the individual sentences contained in the significance paragraphs produced by the original text analysis unit, and generates a summarized text from each of the significance paragraphs, the summarized text containing only a predetermined number of sentences selected in order of the calculated sum of significance indexes.

Cohen teaches allowing a user to audibly and interactively browse through a network of audio information, forming a seamless integration of the world wide web and the entire telephone network browsable from any telephone set. Preferably a browser controller allows the user to receive audio information and to transmit verbal instructions. The browser controller links the user to voice pages, which can be any telephone station or world wide web page, in response to voice commands. Upon linking, certain information is played with an audio indicia which identifies a linking capability. If the user repeats the information set off by the audio indicia, the telephone number or URL of the selected link is transmitted to the browser controller. The browser controller establishes a new link with the identified telephone number or URL, and if successful, disconnects the previous link. The originator no longer needs to know of the existence of the receiver nor the telephone number or URL of the receiver because this invention provides a method to browse the entire telephone network and world wide web and to connect to a receiver by saying the name of the hyperlink. This brings the power of the world wide web to the telephone network. In effect, Cohen teaches taking the PSTN from its current

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state as a set of more than 800 million nodes including means to make pairwise connections and converts it to a highly interconnected browsable web, as well as integrating it with the entire world wide web.

However, the claimed invention includes features, which are patentably distinguishable from the prior art references of record. Specifically, independent claim 1 recites, in part, "...requesting access to a target page. said target page comprising a web page; acquiring said target page; acquiring adjoining pages that adjoin said target page in accordance with a Document Object Model comprising image nodes and text nodes; performing a difference operation to delete objects that are common among said target page and said adjoining pages from said target page to generate a simplified page. wherein said difference operation comprises calculating a significance of the objects included in said target page, wherein if said significance exceeds a predetermined threshold, said objects are not deleted even if said objects are common with the objects of said adjoining pages; and audibly outputting said simplified page."

Similarly, independent claim 14 recites, in part, "...a third server element for acquiring said adjoining pages in accordance with a Document Object Model comprising image nodes and text nodes; ... ; a module for calculating a significance of the objects included in said target page; a module for not deleting said objects if said significance exceeds a first threshold, even if said objects are common with the objects of said adjoining pages; a module for deleting said object if said significance is less than a second threshold, or a content of said objects is an empty table element or list element; and a user browser for audibly outputting said simplified page."

Likewise, independent claim 24 recites, in part, "...a function for requesting access to a target page. said target page comprising a web page; a function for acquiring a target page subject to specification; a function for acquiring adjoining pages that adjoin said target page in

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accordance with a Document Object Model comprising image nodes and text nodes; a function for performing a difference operation for deleting objects that are common among said target page and said adjoining pages form said target page, wherein said difference operation comprises calculating a significance of the objects included in said target page, wherein if said significance exceeds a predetermined threshold, said objects are not deleted even if said objects are common with the objects of said adjoining pages; a function for generating a simplified page; and a function for audibly outputting said simplified page."

These features are simply not taught or suggested in the prior art references of record. First, the Office Action admits (on page 5 of the Office Action) that Sweet does not teach calculating the significance of the objects and deleting them only if the significance is below a predetermined threshold. Second, the Office Action admits (on page 6 of the Office Action) that Sweet does not teach receiving audio outputs (of pages). Thus, Sweet fails to teach all of the elements of the amended independent claims 1, 14, and 24. Therefore, the Examiner is respectfully requested to reconsider and withdraw the 35 U.S.C. §102(e) rejections to the claims.

With regard to the 35 U.S.C. §103(a) rejections to the claims, even if Sweet were legally combinable with both Nishizawa and Cohen, they would still fail to teach all of the elements of the amended independent claims. Specifically, neither Sweet, Nishizawa, nor Cohen teach "acquiring adjoining pages that adjoin said target page in accordance with a Document Object Model comprising image nodes and text nodes," as does the claimed invention. In fact, Sweet (column 9, lines 40-60; column 11, lines 18-62) suggests only comparing images between a target document and a linked document. This is so because Sweet deals with taking elements of various linked documents and combining them into a target document, which is embodied as a PDF file. Those skilled in the art understand that PDF files are image files (as compared with

text files). Thus, images from the linked documents are compared with images of the target documents to determine if any overlapping exists in Sweet. Conversely, the claimed invention compares both image and text nodes and as such, is not limited to the PDF viewer extraction and combining associated with the system in Sweet. While Sweet (column 12, lines 3-27) refers to textually identical documents, those skilled in the art would understand that the textual similarities between PDF files are based on the image nodes contained within the PDF files. That is, textual elements of PDF files are actually images (image nodes), and a comparison of these image nodes from the target document to an adjoining document in Sweet is actually occurring rather than a comparison of both image and text nodes between the target and adjoining documents.

Moreover, the Federal Circuit has provided that, "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference....Rather, we look to see whether combined teachings render the claimed subject matter obvious." In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (C.C.P.A. 1969); In re Mapelsden, 329 F.2d 321, 322, 141 USPQ 30, 32 (C.C.P.A. 1964)). Here, a combination of Sweet, Nishizawa, and Cohen would not render the claimed subject matter obvious because a combination of all three references together would still fail to teach all of the elements of the claimed invention as described above.

Additionally, the Applicants assert that there was no logical basis to combine Sweet with Nishizawa and Cohen at the time of the invention. First, Sweet (priority date-November 1997) deals with the concept of combining linked pages into a target PDF page for the purposes of creating a new PDF page. Nishizawa (priority date-March 1998) deals summarization

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techniques for parsing a document. Cohen (priority date-December 1998) deals with means of browsing a voice web. There is no suggestion in any of the latter-dated references (Nishizawa and Cohen) of combining either reference with one another or with Sweet. In fact, the USPTO has essentially indicated that Cohen is unrelated to as each of Sweet and Nishizawa as Cohen has been designated a wholly separate and unique publication classification than either Sweet or Nishizawa. The Federal Circuit has required that prior art references must be either in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor is involved. See In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). As such, Cohen should properly be considered non-analogous art, which would be practically unavailable (i.e., no logical reason to be aware of) to one of ordinary skill in the art. Furthermore, one of ordinary skill in the art would not be motivated to combine three distinct and mutually exclusive processes and systems which purportedly solve separate and unique problems such as Sweet, Nishizawa, and Cohen.

Insofar as references may be combined to teach a particular invention, and the proposed combination of Sweet, Nishizawa, and Cohen, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 USPQ 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal. Inc. v. Rudkin-Wiley Corp., 5 USPQ 2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the

hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the

desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is

improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for

a part of another reference in order to try to meet, but failing nonetheless, the Applicant's novel

claimed invention. Furthermore, the claimed invention, as amended, meets the above-cited tests

for obviousness by including embodiments such as considering both image and text nodes of the

target and adjoining pages and audibly outputting the simplified page. As such, all of the claims

of this application are, therefore, clearly in condition for allowance, and it is respectfully

requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

> In proceedings before the U.S. Patent and Trademark Office, the Examiner bears
> the burden of establishing a prima facie case of obviousness based upon the prior
> art. The Examiner can satisfy this burden only by showing some objective
> teaching in the prior art or that knowledge generally available to one of ordinary
> skill in the art would lead that individual to combine the relevant teachings of the
> references. In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) citing In re
> Fine, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of

obviousness. It is clear that, not only does Sweet fail to disclose all of the elements of the claims

of the present invention, particularly, the image and text nodes and audible output, as discussed

above, but also, if combined with Nishizawa and Cohen, fails to disclose these elements as well.

The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

> The mere fact that the prior art may be modified in the manner suggested by the
> Examiner does not make the modification obvious unless the prior art suggested
> the desirability of the modification. . . . Here the Examiner relied upon hindsight

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to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Sweet, alone or in combination with Nishizawa and Cohen teaches a method and system containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

In view of the foregoing, the Applicants respectfully submit that the cited prior art references, Sweet, Nishizawa, and Cohen are not legally combinable, and even if they were, they still do not teach or suggest the features defined by independent claims 1, 14, and 24 (and newly added independent claim 25) and as such, claims 1, 14, 24, and 25 are patentable over Sweet alone or in combination with Nishizawa and Cohen. Further, dependent claims 2-6, 8-13, 15-18, 20-23, and 26-27 are similarly patentable over Sweet alone or in combination with Nishizawa and Cohen, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

IV.   Formal Matters and Conclusion

With respect to the objections/rejections to the specification/claims, the specification and claims have been previously amended to overcome these rejections. Therefore, the Examiner is

respectfully requested to reconsider and withdraw the objections/rejections to the specification/claims.

In view of the foregoing, Applicants submit that claims 1-6, 8-18, and 20-27, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 50-0510.

Respectfully submitted,

Dated: April 15, 2004
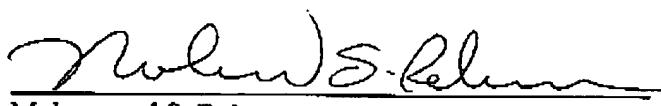
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